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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,068	02/06/2004	Scott A. Koerner	1057143	2067
27062	7590	10/03/2006	EXAMINER	
OSLER, HOSKIN & HARCOURT LLP (BRP2) 2100 -1000 DE LA GAUCHETIERE ST. WEST MONTREAL, H3B4W5 CANADA			KWON, JOHN	
			ART UNIT	PAPER NUMBER
			3747	

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/708,068

Applicant(s)

KOERNER ET AL.

Examiner

John T. Kwon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-28 and 37-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-28 and 37-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The finality of the last Office action is withdrawn.

The indicated allowability of claims 21-23 and 42-44 is withdrawn in view of the newly discovered reference(s) to Renz (US 3 960 011) and Boisvert (US 5 729 456). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-20, 24-28, 37-41 and 45-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koerner (US 6 820584) in view of Bouse (US 2004/0019461). Koerner discloses an outboard motor with an internal combustion engine, a fault indicator, wherein the indicator provides at least one form of feedback to a user regarding at least one of an operational condition at start-up and an operational condition during running. However, Koerner does not show the use of a plural fault indicator, the particular location for the indicator (directly mounted on the outboard engine), or the use of a rope-start engine. Bouse teaches the use of plural sensors to detect the operational conditions of the equipment and produce a feedback signal to the controller to indicate various fault/error/malfunction of the machine. Since the prior art

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references art from the same field of endeavor, the purpose disclosed by Bouse would have been recognized in the pertinent art of Koener. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide the device of Koener with the plural indicator as taught by Bouse. Regarding the claimed particular location for the indicator, i.e., mounted on the engine, it would be considered as the relocation of the known device for its known function since the applicants have admitted in the specification that the provision of the fault indicators on the dashboard is old and well known in the art (page 2, [0002]). Thus, relocating the known device would be within the ability of one of ordinary skill in the art.

Regarding the use of a particular type of engine such as rope start engine, it would be a matter of design to choose an engine among the various known engines since the specification fails to indicate any criticality of using a particular engine such as a rope-start engine.

Claims 38-40 and 45, 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koerner (US 6 820584). Koerner discloses an outboard motor with an internal combustion engine, a fault indicator, wherein the indicator provides at least one form of feedback to a user regarding at least one of an operational condition at start-up and an operational condition during running. The differences between the prior art reference and the instant invention are the location of the indicator (directly mounted on the outboard engine) and the use of a rope-start engine. Since the applicants have admitted in the specification that the provision of the fault indicators on the dashboard is old and well known in the art (page 2, [0002]), relocating the known device such as fault indicators would be within the ability of one of ordinary skill in the art. Regarding the use of a particular type of engine such as rope start engine, it would be a matter of design to choose

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an engine among the various known engines since the specification fail to indicate any criticality of using particular engine such as a rope-start engine.

Claims 18-24, 26-28, 37, 41-44 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koerner (US 6 820584) in view of Renz (US 3 960 011). Koerner discloses an outboard motor with an internal combustion engine, a fault indicator, wherein the indicator provides at least one form of feedback to a user regarding at least one of an operational condition at start-up and an operational condition during running. However, Koerner does not show the use of a plural fault indicator, the particular location for the indicator (directly mounted on the outboard engine), or the use of a rope-start engine. Renz show that the use of plural fault indicators for the internal combustion engine is old and well known in the art. Since the prior art references art from the same field of endeavor, the purpose disclosed by Renz would have been recognized in the pertinent art of Koerner. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide the device of Koerner with the plural fault indicators as taught by Renz. Regarding the claimed particular location for the indicator such as mounted on the outboard motor, relocating the known device such as fault indicators would be within the ability of one of ordinary skill in the art since the applicants have admitted in the specification that the provision of the fault indicators on the dashboard is old and well known in the art (page 2, [0002]). Regarding the use of a particular type of engine such as rope start engine, it would be a matter of design to choose an engine among the various known engines since the specification fail to indicate any criticality of using particular engine such as a rope-start engine.

Claims 25 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koerner in view of Renz as applied to claim 18 above, and further in view of Boisvert (US 5 729 456). Boisvert shows that the use of a recordable medium is old and well known in the art (Abstract, Claim 4). Since the prior art references art from the same field of endeavor, the purpose disclosed by Boisvert would have been recognized in the pertinent art of Koerner as modified. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide the device of Koerner with the recordable medium as taught by Boisvert.

Response to Arguments

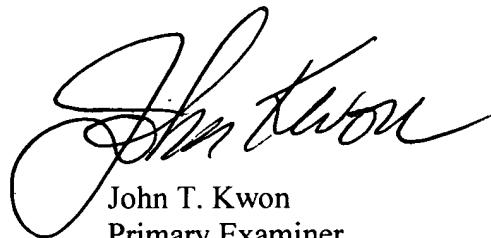
Applicant's arguments filed May 15, 2006 have been fully considered but they are not persuasive. Attorney argues that Bouse is not an analogous art because Bouse does not disclose an outboard motor and there is no suggestion to combine. The examiner disagreed because there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re Simmon, 174 USPQ 114; In re McLaughlin, 170 USPQ 209. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545. Accordingly, the teaching of using more than one faulty indicator for monitoring the machine would be applied to the machine which is already used one sensor.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John T. Kwon whose telephone number is (571) 272-4846. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Cronin can be reached on (571) 272-4536. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "John T. Kwon", is positioned above the printed name and title.

John T. Kwon
Primary Examiner
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September 21, 2006